

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

I. Claim Status / Explanation of Amendments

Claims 1, 3-4, 7, 15-19, and 22 are pending and were rejected, and claim 21 was previously withdrawn from consideration. Applicants reserve the right to pursue the withdrawn claim in a divisional application.

By this paper, claim 1 is amended, claim 22 is cancelled without prejudice or disclaimer, and new claims 23-24 are added. Applicants reserve the right to pursue the cancelled claim in a continuing application. Claim 1 is amended such that the aspect in which the "film [is] adapted to be formed on a sliding part" is removed from the preamble. New claim 23 is analogous to previously presented claim 1, but with the transitional phrase "comprising" changed to "consisting essentially of." New claim 24 is analogous to previously presented claim 1 and has been amended to recite, *inter alia*, that "the coating composition comprises no polyamide."

Support for new claims 23-24 may be found throughout the application as originally filed including, for example, the compositions disclosed in Tables 1-4. As an example, composition C8 in Table 1 contains a binder resin, which is polyamide-imide, a solid lubricant of polytetrafluoroethylene in an amount of 43.1% by mass based on 100% by mass of the binder resin, titanium oxide powder in an amount of 7.7% by mass based on 100% by mass of the binder resin, and a silane coupling agent in an amount of 3.1% by mass based on 100% by mass of the binder resin. Accordingly, composition C8 meets the claimed composition. Composition C8 also contains a binder resin of

65% by mass, the solid lubricant of 28% by mass, the titanium oxide powder of 5% by mass, and the silane coupling agent of 2% by mass, and the total of these four components is 100% by mass ($65 + 28 + 5 + 2 = 100\%$). This means that composition C8 does not contain components other than the claimed four components and thus provides support for the recitation of "consisting essentially of" in new claim 23 and "the coating composition comprises no polyamide" in new claim 24.

No new matter will be introduced into this application by entry of these amendments. Entry is respectfully requested.

II. Rejections Under 35 U.S.C. § 112:

Claim 22 was rejected pursuant to 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. [6/7/2010 Office Action, p. 2]. In order to expedite prosecution of this application, claim 22 has been cancelled without prejudice or disclaimer. Accordingly, the Section 112 rejection of claim 22 has been rendered moot.

III. Rejections Under 35 U.S.C. § 103:

The rejection of claims 1, 3-4, 7 and 15-19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 4,742,110 to Sakashita, et al. (hereinafter "Sakashita") was maintained in the Advisory Action. [10/19/2010 Office Action, p. 2]. Applicants respectfully traverse the rejection since, as set forth in detail below, Sakashita fails to teach or disclose a coating composition consisting of a polyimide or polyamide-imide binder resin. That is, "polyimide or polyamide-imide" resin recited in claim 1 is patentably different from "the polyamide composition" described in Sakashita.

In response to Applicants' amendments and arguments of October 7, 2010, the Advisory Action contends that

Considering the fact that the reference discloses all the claimed component and make the instant claims obvious as detailed out in the previous Office Action, and considering the fact that the instant claims recite the phrase "comprising", the composition disclosed by the reference as a whole is expected to have characteristics that applicants argue that are seen in their claimed composition absence evidence to the contrary. [10/19/2010 Advisory Action, p. 2].

Applicants respectfully disagree with the Office Action and reassert that "the polyamide composition" described in Sakashita is inadequate for use as a sliding film for a sliding part.

As previously noted, Sakashita patent describes that imide-based resins such as polyimides and polyamide-imides may be incorporated into the polyamide composition. See column 6, lines 19-22. However, the description is that these imide based resins are merely exemplified as "stabilizers, plasticizers, parting agents, lubricants and fillers." See column 5, line 68 of column 6, line 1. A person of ordinary skill in the art would believe that the addition of the imide-based resin is to improve the properties of the composition by adding solid filler which does not melt under high temperature.

The imide-based resin of the present invention also acts as a binder resin, when it is dissolved, which securely adheres the sliding film to the sliding part body, or solid lubricants and/or titanium oxide powders contained in the coating composition to the sliding film. On the other hand, even if it is suggested in Sakashita patent that imide-based resins are added, the imide-based resins does not function as a binder resin.

Exhibits A to D in Applicants' October 7, 2010 reply are provided to support Applicants' explanation that polyamide has completely different characteristics from the polyimide or polyamide-imide and thus cannot be used as a binder resin. Sakashita discloses that imide-based resins such as polyimides and polyamide-imides are added. However, Sakashita does not disclose that the imide-base resins are used as a binder resin. In addition, Sakashita does not disclose that "the film is adapted to be formed on a sliding part by applying the coating composition to the sliding part and curing the applied coating composition" as recited in Applicants' amended claim 1.

Accordingly, Sakashita fails to teach, disclose, or suggest a "wear resistant and seizure resistant film wherein the film is formed of a coating composition comprising a binder resin, which is polyimide or polyamide-imide" as recited in Applicants' amended claim 1. Applicants submit that claim 1 is patentable over Sakashita for at least this reason. Claims 3-4, 7, and 15-19 are also deemed to be in condition for allowance by way of their direct or indirect dependence on claim 1.

Applicants therefore respectfully request that the Section 103 rejection of claims 1, 3-4, 7, and 15-19 be withdrawn and submit that these claims are now allowable for the above reasons. Early, favorable action in that regard is respectfully requested.

IV. New Claims 23 and 24

Applicants submit that newly added claims 23 and 24 are allowable over the prior art of record.

In response to Applicants' claim amendments and arguments of March 10, 2010, in which it was noted that Sakashita's composition includes polyamide as a main component, the Office Action contended that the

instant claims recite the language of "comprising" which is an open language, considering the fact that the references teaches the components of the recited claims or make obvious (see previous Office Action) clearly reads on the recitation of the instant claims ... [6/7/10 Office Action, p. 3].

In response to Applicants' October 7, 2010, reply, the Advisory Action further contends that

the use of the phrase 'comprising' in the recitation of instant claims allows for the use of other components in the claimed composition which are not limited to the recited resin, titanium dioxide, polytetrafluoroethylene, and silane coupling agent. [10/19/10 Advisory Action, p. 2].

Applicants' new claim 23 recites, *inter alia*, a wear-resistant and seizure-resistant film formed of a "coating composition consisting essentially of a binder resin, which is polyimide or polyamide-imide" (emphasis added). "The transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps and those that do not materially effect the basic and novel characteristic(s) of the claimed invention." MPEP § 2111.03. Applicants respectfully submit that use of the claim language "consisting essentially of" limits the binder resin to either polyimide or polyamide-imide and excludes the inclusion of polyamide. Applicants' new claim 24 recites, *inter alia*, a wear-resistant and seizure-resistant film "wherein the coating composition comprises no polyamide" and, hence, specifically excludes the inclusion of polyamide. Since Sakashita's composition includes polyamide as the primary

constituent, Applicants respectfully submit that new claims 23 and 24 are not obvious in view of Sakashita.

Accordingly, Sakashita fails to teach, disclose, or suggest a wear resistant and seizure resistant film adapted to be formed on a sliding part in which "the film is formed of a coating composition consisting essentially of a binder resin, which is polyimide or polyamide-imide" as recited in Applicants' new claim 23 or in which "the coating composition comprises no polyamide" as recited in Applicants' new claim 24. Applicants therefore respectfully submit that new claims 23-24 are patentable over Sakashita for at least these reasons.

Applicants have chosen in the interest of expediting prosecution of this patent application to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art. Likewise, Applicants have chosen not to swear behind the references cited by the Office Action, or to otherwise submit evidence to traverse the rejection at this time. Applicants, however, reserve the right, as provided by 37 C.F.R. §§ 1.131 and 1.132, to do so in the future as appropriate. Furthermore, Applicants have not specifically addressed all rejections of the dependent claims. Applicants respectfully submit that the independent claim from which they depend is in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicants, however, reserve the right to address such rejections of the dependent claims in the future as appropriate.

CONCLUSION

In light of the foregoing claim amendments and response, Applicants respectfully submit that all of the pending claims are now in condition for allowance. Thus, it is respectfully requested that the rejections under §§ 112 and 103 be withdrawn, and all the claims be allowed such that this application may expeditiously pass to issue.

AUTHORIZATION

The Commissioner is hereby authorized to charge any fees which may be required for consideration of this Document to Deposit Account No. **504827**, Order No. **1004378.51670**. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **504827**, Order No. **1004378.51670**.

Respectfully submitted,
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